

## REMARKS

Applicants have reviewed and considered the non-final Office Action mailed on February 2, 2007, and the references cited therewith. Claims 1-18 and 28-45 are pending. The Applicants respectfully request reconsideration and allowance of all pending claims in view of the following remarks.

### *Relevancy of the Tiberia Declaration*

The Office Action asserts that the Tiberia declaration is irrelevant and does not contain statements related to patentability. This is not the case. The statements presented by Tiberia have direct bearing on the case at hand. A person of ordinary skill in the art of this invention is a person skilled in organo-silicone chemistry that also has knowledge of the procedures and processes associated with wine making. Indeed, the originally-filed specification points out the problems associated with existing wine bottle stoppers, including chemicals that are harmful to wine. These disclosures support the contention that a person of ordinary skill in the art would know information about the wine industry and wine making. Since Tiberia has knowledge pertinent to that of a person of ordinary skill in the art, it is unclear why there has been a refusal to consider this knowledge. Tiberia makes clear that wine makers would never add natural cork to a batch of wine as an additive, and also that the "oak dust" used by wineries to flavor wine would never be considered to include natural cork. These statements are highly relevant to the patentability of the claims at issue since the definition and usage of the term oak dust throughout the specification is consistent with the oak dust that is used by wineries and that which is addressed by Tiberia. Refusal to consider the statements of Tiberia as relevant is erroneous, and

Applicants respectfully request that the statements contained in the Tiberia declaration be reconsidered.

***Claim Rejections – 35 USC § 112***

Claims 28-45 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse this rejection.

The Office Action points to the limitation of Claim 28 that reads “oak dust that does not consist of natural cork.” The Office Action has not identified a limitation of Claim 37 that is alleged to be non-enabled; however, it is assumed that independent claim 37 is considered non-enabled since this claim and its dependents were listed as being rejected under § 112, paragraph 1. In order to advance the prosecution of the application, Applicants will assume that the Examiner intended to identify the limitation of Claim 37 that reads “oak dust not comprising natural cork” as being non-enabled.

Applicants respectfully submit that Claims 28 and 37 are enabled by the originally-filed specification. “The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778 (Fed. Cir. 1988). When considering whether a claim is enabled, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). The originally-filed specification is enabling with respect to the limitations directed to oak dust not comprising or consisting of natural cork. The specification states that oak dust is used by the wine industry to enhance the flavor of wine. The Tiberia declaration clarifies that oak dust used by wineries does not include natural cork.

A person of ordinary skill in the art would be able to determine without undue experimentation that oak dust does not include natural cork. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504 (CCPA 1976). The application states in clear terms that the oak dust used in the compound of Applicants' claimed invention may be obtained from World Cooperage, a winery supply house. Without undue experimentation, a person of ordinary skill in the art would be able to contact World Cooperage or any other wine supply house and obtain oak dust. A visit to the website of World Cooperage at [www.worldcooperage.com](http://www.worldcooperage.com) reveals that oak dust sold by the company (information contained at [www.oaksolutionsgroup.com](http://www.oaksolutionsgroup.com)) does not include ground or powdered natural cork. For the convenience of the Examiner, Applicants include information from these websites with this response. The information available from World Cooperage is consistent with the declaration of Tiberia, which clarifies that wineries do not add natural cork to wine. Since a person of ordinary skill in the art would be able to easily determine that oak dust, as contemplated by the originally-filed application, does not comprise or consist of natural cork, the specification is enabling of the limitations of claims 28 and 37.

Moreover, Applicants note that the Examiner has not met the burden imposed upon an Examiner to show non-enablement of a claim. In order to make a rejection, the Examiner has an initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). The minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement. *In re Bowen*, 492 F.2d 859, 862-63 (CCPA 1974). The language provided by the Examiner should "focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any

enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.” See MPEP § 2164.04. The Examiner in the present case has not met this burden. The Office Action does not address how a person of ordinary skill in the art would view the information provided in the specification about oak dust, nor the amount of “experimentation” that would be required for that person to understand that oak dust does not include natural cork. In fact, undue experimentation is not even mentioned in the Office Action. Because claims 28 and 37 are enabled by the originally-filed specification, and because the Examiner has not met the burden for showing enablement, Applicants respectfully request that the rejection of claims 28 and 37 and their respective dependant claims under 35 U.S.C. § 112, first paragraph be withdrawn.

### ***Claim Rejections – 35 USC §103***

The Examiner has maintained his rejections of Claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya I (U.S. Patent No. 5,981,610), or Meguriya II (U.S. Patent No. 6,506,331), and further in view of Descamps et al (U.S. Patent No. 5,162,397), Strauss (U.S. Patent No. 4,031,059), and Snogren (U.S. Patent No. 3,296,153) all taken together.

### **References Do Not Teach or Suggest All of the Claimed Limitations**

An applicant’s claimed invention may be unpatentable under 35 U.S.C. § 103 only if it would have been “obvious” to a person of ordinary skill in the art to modify or combine the prior art in order to meet the claims, even if a single reference does not anticipate the claimed invention. See 35 U.S.C.A. § 103(a) (West, WESTLAW through P.L. 110-36 approved 06-15-07); *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 727 (Fed. Cir. 2002) (stating that “obviousness may render a claimed invention invalid where the record contains a suggestion or motivation to

modify the prior art teaching to obtain the claimed invention,” even if the prior art does not “reach expressly each limitation exactly”); *Hartness Int’l, Inc. v. Simplimatic Eng’g Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987) (“the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”). “Obviousness” is a legal conclusion based on underlying findings of fact. *In re Peterson*, 315 F.3d 1325, 1328 (Fed. Cir. 2003). The underlying factual inquiry includes determining “the scope and content of the prior art;” ascertaining the “differences between the prior art and the claims at issue;” and resolving “the level of ordinary skill in the pertinent art.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001).

The Examiner, though, carries the initial burden of establishing a prima facie case of obviousness before rejecting a claimed invention under 35 U.S.C. § 103. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *In re Alton*, 76 F.3d at 1175; *In re Oetiker*, 977 F.2d at 1445; *In re Wertheim*, 541 F.2d at 263 & 265; United States Patent & Trademark Office, MPEP §§ 2141, 2142, 706.02(j) (8th ed. rev. 5 2006); see also 35 U.S.C.A. § 132. To establish prima facie obviousness of a claimed invention, the Examiner must demonstrate with substantial evidence that all the claim limitations are taught or suggested by the prior art. See, e.g., *In re Zurko*, 258 F.3d at 1384-85 (holding invention was not obviousness because prior art failed to teach single element); *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1986) (finding that prior art was deficient in at least one element); accord MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)).

Independent claims 1 and 10 are allowable because none of the cited references teach or suggest all of the claimed limitations. Among other things, the references do not teach or suggest *oak dust* in any amount. As stated in Applicants’ originally-filed specification, the

inclusion of oak dust (toasted or untoasted), gives the resulting synthetic cork compound a mottled, speckled, or non-uniform appearance that closely resembles natural cork (see paragraph [0025]). This is important since one of the many possible uses of Applicants' compound is to provide a synthetic alternative to natural cork stoppers in wine bottles. The wine industry has in many cases been slow to adopt synthetic stoppers, and one commonly-stated reason for this is that synthetic stoppers do not closely resemble natural cork stoppers. Hence, the inclusion of oak dust as an ingredient greatly increases the likelihood of acceptance of Applicants' product as a synthetic substitute for natural cork wine stoppers. The effects of oak dust on Applicants' claimed invention are supported by the previously-submitted Affidavit of Jeannie Holmes.

Both Snogren and Strauss are cited in the Office Action for the teaching of ground cork or granulated cork in a silicone resin (emphasis added), and according to the Office Action, these elements teach or suggest the oak dust component of Applicant's claimed invention. Applicant respectfully disagrees with this assertion and submits that neither granulated cork nor ground cork teaches or suggests oak *dust*. Granulated and ground cork teaches and suggests particle sizes that are larger than dust, and neither references makes mention of "dust" or "cork dust".

If the Examiner wishes to rely upon an inherency argument to state that oak dust is taught or suggested by Snogren or Strauss, Applicant reminds the Examiner that a rationale or evidence must be provided tending to show inherency. *See* MPEP 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex*

*parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Inter. 1990). In the instant case, the teachings of Snogren and Strauss do not absolutely and necessarily teach a dust, let alone oak dust.

### **Failure to Provide Articulated Reasoning**

The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). But most, if not all, inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d at 1357). “Thus, every element of a claimed invention may often be found in the prior art” and the Examiner must consider the claimed invention as a whole. *Id.* at 1369-70; accord MPEP § 2141.02. “[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *Kotzab*, 217 F.3d at 1370. The Examiner may not evaluate the invention “part by part,” using the invention as a “roadmap to find its prior art components.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005). Hindsight reconstruction is impermissible. *Rouffet*, 149 F.3d at 1357-58; *In re Fitch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Moreover, an alleged reason for combining the teaching of the prior art must be supported by articulated reasoning with some “rational underpinning” to support the legal conclusion of obviousness. See *KSR*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Broad conclusory statements of suggestion or motivation standing alone are not sufficient. *Id.*

The Office Action concedes that the primary references do not disclose oak dust in the amount claimed. The Office Action relies on Snogren and Strauss to fill this void. Thus, assuming *arguendo* that Snogren and Strauss teach all that is alleged, the Examiner must

nonetheless demonstrate with articulated reasoning that a person having ordinary skill in the art would have an apparent reason to combine the teachings of Oka, Merguriya I, or Meguriya II with the teachings of Snogren and Strauss such that the Applicants' claims as a whole are unpatentable. See *KSR*, 127 S. Ct. at 1741. The Examiner has failed to satisfy this burden. See 35 U.S.C. § 132; MPEP §§ 2141, 2142, 706.02(j).

The references that the Examiner cites not only fail to teach or suggest all of the claimed limitations, as discussed above, but the Examiner merely provides broad conclusory statements regarding the apparent reason to combine the references in a manner that would render the claims obvious. The Office Action states that the "references represent art analogous in scope" such that "one having ordinary skill in the art would have a high level of expectation of success." The Examiner does not provide an articulated reasoning with rational underpinnings to explain how providing a silicone-based compound would motivate one to incorporate oak dust from an ablative compound to arrive at a material that resembles natural cork in both appearance and physical properties.

Consequently, the Examiner has failed to meet the burden of a prima facie case of obviousness under § 103, and the Applicants respectfully request that the rejection of claims 1-18 be withdrawn.

#### ***Double Patenting Rejection***

As amended, and for the reasons stated above, Claims 1-18 overcome the nonstatutory obviousness-type double patenting rejection over Claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren and Oka.

Applicant respectfully requests that the double patenting rejection be withdrawn.




## CONCLUSION

In light of the foregoing, believing that all things raised in the Office Action have been addressed, Applicants respectfully request reconsideration of the prior rejections, as well as allowance of the claims and passage of the application to issue. If the Examiner would care to discuss any remaining matters by phone, Applicants invite the Examiner to contact the undersigned at 214.758.6641.

Respectfully submitted,

DATE: 8/2/07

  
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Robert C. Hilton  
Reg. No. 47,649  
PATTON BOGGS LLP  
2001 Ross Avenue  
Suite 3000  
Dallas, Texas 75201  
TEL: 214- 758-6641  
FAX: 214-758-1550

ATTORNEYS FOR APPLICANTS



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## Toasted Oak Powder

evOAK toasted oak powder enhances overall wine quality without imparting oak character. Designed for use prior to barrel ageing, it removes vegetal overtones without imparting obvious oak character (when used at prescribed doses). evOAK toasted oak powder is ideal for fermentation and addition at the hopper and its small particle size makes for easy processing and removal.

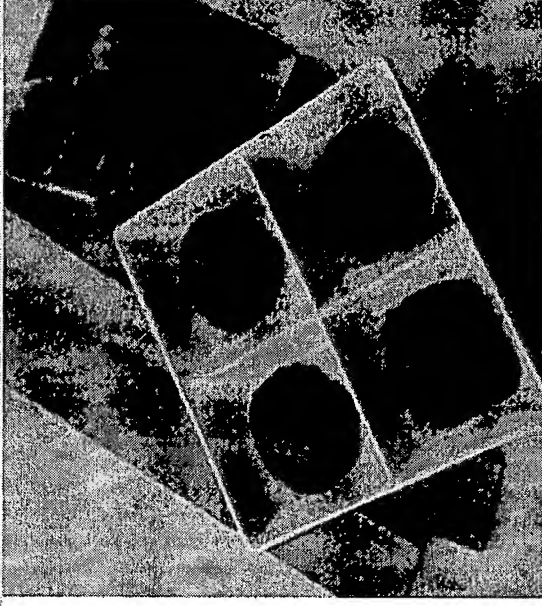
During blind tastings with 400 wine professionals worldwide, greater than 85% preferred the wine enhanced by oak powder to the same untreated base wine.

**Origin:** French oak, air dried 24 months, certified Bureau Veritas  
American oak, air dried 24 months, audited Ernst & Young

**Size:** Powder

**Toast Level:** House toast

**Packaging:** Packaged loose in 40 lb. (18 kg) bags. Can be purchased in stackable, forklift-ready, rain-protected pallet boxes.





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